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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,741	07/03/2003	John C. S. Koo	31045-101	5633

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Mitchell, Silberberg & Knupp, LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,741

Applicant(s)

KOO, JOHN C. S.

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the partially coating of the bottom surface, including some but not all of the indentations, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Applicant specifically refers to Figure 4 to show the coating of the bottom surface, but this figure, as well as any other figure of record, fails to show the protrusions with coatings and the indentations substantially uncoated. The figures fail to show any view that shows the protrusions coated as none of the figures that show the coating actually shows the protrusions as well.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 11-12, 19-20 and 24-29-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Kester et al. 4,356,643 in view of Shin 4,658,514. Kester '643 discloses substantially all the limitations of the claims including the following: a shoe (see Figure 2) comprising a bottom surface (bottom of 11) that is adjacent to the ground in normal use and that has a plurality of indentations (that located between projections 14), with lower extending portions 14 between the indentations (see Figure 2); a sole 11 that forms at least a portion of the bottom surface; an upper portion 13 extending above the sole; a plurality of small particles 18 bonded (see col. 2, lines 16-19) to at least some of the lower extending portions (see Figure 2); at least 1,000 small particles are bonded to the at least some lower extending portions (see Figure 3); the small particles are bonded to the at least some of the lower extending portions using adhesive material (see col. 2, lines 16-19); the small particles comprises a fabric material (18 is made of nylon material, a fabric material); the small particles have been bonded directly onto the at least some of the lower extending portions (see Figures 2 and 3); the sole is sufficiently durable for commercially acceptable outdoor use (see col. 2, lines 20-31); the sole includes an outsole that is comprised of at least one of leather, natural rubber and synthetic rubber (see col. 1, lines 43-49); the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figures 1-3); the sole is sufficiently strong for commercially acceptable outdoor use (see col. 1, lines 4-47); the bottom surface has at least five indentations (see Figure 2); at least some of the indentations are very narrow (see potion at front edge of heel); at least one of the indentations is

approximately 1-2 millimeters in width (see indentations in forefoot area); at least some of the indentations are closely spaced (see First two indentations at front edge of heel in Figure 2); at least two of the indentations are separated from each other by no more than approximately 2 millimeters (see first two indentations at front edge of heel; a plurality of small particles bonded differentially to different areas of the bottom surface (see Figures 1 and 5, bonded in different directions); the indentations ordinarily do not contact the ground (see Figure 2). Kester et al. '643 does not disclose each of the plurality of projections is predominantly uncoated with the small particles or the lower extending portions being coated more than each of the plurality of indentations. Shin '514 teaches that the sole of a shoe can have protrusions 76 and indentations (slots 50, see col. 3, lines 10-23) with the protrusions having ridges 78 applied thereto to aid in affording traction to the user. Shin '514 further teaches that the indentations (slots 50) are provided to act as hinges and allow bending of the sole. Shin '514 shows these indentations without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to remove the traction elements 16, 17, 18 from the sole of Kester et al. '643, or not place these traction elements, in the area of the indentations to allow the sol to completely flex without removing the traction gained by adding these elements to the protrusions. Furthermore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to not place these traction elements in the indentations of Kester et al. '643, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art, *In re Karlson*, 136 USPQ 184.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3728

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Knoche et al. 6,782,642. The references as applied above disclose all the limitations of the claim except for the small particles being bonded to at least some of the lower extending portions by embedding the small particles directly into the bottom surface using at least one of heat and pressure. Knoche et al. '643 teaches that particles attached to the bottom of a sole can be placed in a molded and pressed or embedded into the sole to help hold the particles on the sole to gain traction. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to embed the particles of the references as applied above into the sole surface to aid in holding the particles to the surface to aid in gaining traction.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 5 above in view of Giese, Jr. 2,663,097. The references as applied to claim 5 disclose all the limitations of the claim except for the fabric particles being applied by a flocking technique. Giese, Jr. '0097 teaches that particles can be attached to the sole of a shoe by flocking to help gain traction on slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to flock the particles onto the bottom sole of the shoe to help hold the particles onto the bottom of the shoe to gain traction, as taught by Giese, Jr.

7. Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Official Notice. The references as applied to claim 1 above disclose all the limitations of the claims except for the for the particle material being made of natural or synthetic leather, natural or synthetic rubber, plastic, Official Notice is taken that it is well known within the art of anti-slip material to use natural or synthetic leather, natural or synthetic rubber or plastic particles to prevent slipping of one surface on another. Therefore, it would have been obvious to one of

Art Unit: 3728

ordinary skill in the art at the time the invention was made, to make the particles of the references as applied to claim 1 out of natural or synthetic leather, natural or synthetic rubber, or plastic as these materials are well known and used in the art for aiding in slip prevention.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Bible 4,779,360. The references as applied to claim 1 above discloses all the limitations of the claim except for the particles comprising metal. Bible '360 teaches that grit material used to gain grip on slippery surfaces can be made of aluminum oxide, silicon carbide or tungsten carbide (i.e. metals) for their durability, less tendency to crumble and their hardness to scratch or furrow up metallic slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the grit particles of the references as applied to claim 1 above out of metal, as taught by Bible '360, to aid in gaining grip on metallic or rough surfaces.

9. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claim 1 above. The references as applied to claim 1 above disclose all the limitations of the claims except for the ASTM tear resistance and abrasion resistance requirements. It appears that since these requirements are standards, it would be well within the skill of one of ordinary skill in the art to make a sole to meet these requirements. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of the references as applied to claim 1 above meet the tear and abrasion resistance standards.

10. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 in view Schaffer et al. 5,276,981. The references as applied to claim 1 above disclose all the limitations of the claims except for the particle wearing off over certain time frames. Schaffer et al. '981 teaches that the material for particles attached to the bottom of shoe soles to aid in gaining traction can be modified to wear over given time frames, including weeks (see col. 2, lines 3-21). Therefore, it would have been well within the skill of one of ordinary skill in the art, to modify the

Art Unit: 3728

material of the particles attached to the sole of the references as applied to claim 1 above to last over any time period desired, as taught by Schaffer et al. '981, to determine the wear life of the sole of the shoe.

Response to Arguments

11. Applicant's arguments filed April 26, 2006 have been fully considered but they are not persuasive. Applicant argues that there is no specific teaching in Shin as to why one would modify Kester et al. in the manner set forth in the rejection. The reason to combine the references does not have to specifically come from the references themselves, but can come from the knowledge of one of ordinary skill in the art as well. A reason to combine the references was given by the examiner and other reasons were also stated by the applicant, all of which are viable reasons to combine the references. Therefore, the rejections set forth above stand and are hereby made **FINAL**.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3728

13. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/613,741

Page 9

Art Unit: 3728

A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is fluid and cursive, with the first name "Anthony" written in a larger, more prominent script than the last name "Stashick".

Anthony Stashick
Primary Examiner
Art Unit 3728

ADS